

Serial No.: 09/923,250
Conf. No.: 9145

- 9 -

Art Unit: 2854

REMARKS

Applicant respectfully requests reconsideration. Claims 1-7 and 9-49 were previously pending in this application. By this amendment, Applicant is canceling claims 25-29, 37-45, and 48-49 without prejudice or disclaimer. Claims 1, 13, 46 and 47 have been amended. As a result, claims 1-7, 9-24, 30-36, and 45-47 are pending for examination with claims 1, 30, 46 and 47 being independent claims. No new matter has been added.

Summary of Telephone Conference with Examiner

Applicant's representative Michael J. Pomianek, Reg. No. 46,190 (hereinafter "the undersigned"), thanks Examiner Ren Luo Yan for the courtesy of a telephone interview conducted on March 4, 2005 with the undersigned,. The following is a complete written statement of the substance of the interview and the reasons presented during the interview as warranting favorable action, in accordance with requirements of 37 C.F.R. §1.133(b) and MPEP §713.04.

On February 24, 2005, the undersigned telephoned Examiner Yan and requested an interview to discuss the rejections under 35 U.S.C. §103(a) of claims 1-7, 9-29, 37 and 45-49 over U.S. Patent No. 3,916,823 to Halloran in view of U.S. Patent No. 4,497,249 to Mitter made in the Final Office Action. The undersigned indicated that in order to expedite allowance, Applicant was willing to amend independent claim 1 to include certain limitations similar to those recited in allowed independent claim 30. The undersigned indicated that Applicant would cancel the remaining independent claims, except for claims 46 and 47. The Examiner indicated that he was amenable to interviewing the application and he requested that the undersigned fax to him, at his personal office fax number, his proposed claim amendments. The date for the telephone interview was set for March 4, 2005. Attached hereto as an appendix is a copy of the facsimile sent by the undersigned to the Examiner on February 28, 2005 in preparation for the telephone interview.

The undersigned telephoned the Examiner on March 4, 2005 to conduct the telephone interview. During the interview, the rejections under 35 U.S.C. §103(a) based on the combination of Halloran in view of Mitter were discussed. Specifically, this basis for rejection was discussed in the context of independent claims 1, 46, and 47.

Serial No.: 09/923,250
Conf. No.: 9145

- 10 -

Art Unit: 2854

At the outset of the interview, the undersigned indicated to the Examiner that Applicant did not concede the propriety of the proposed combination of the Halloran reference in view of the Mitter reference, and that, in fact, the Applicant disputed that there would have been any motivation to combine the teachings of the references along the lines suggested in the Final Office Action. However, the undersigned indicated that purely for the purpose of expediting allowance, Applicant was willing to amend independent claim 1, as indicated in the facsimile of proposed amendments, to patentably distinguish the combination of the Halloran and Mitter patents proposed in the Final Office Action. The undersigned indicated to the Examiner that the Applicant was in no way conceding the propriety of the proposed combination and that the Applicant may choose to pursue any subject matter cancelled to secure allowance of the present application in a continuation application in which Applicant would present arguments showing that the proposed combination of Halloran in view of Mitter was not supportable.

Regarding independent claim 1, the Examiner indicated that the proposed amendments were sufficient to overcome the rejection of claim 1 and place claim 1 in condition for allowance.

Regarding independent claims 46 and 47, the undersigned noted that, contrary to certain statements made in the Final Office Action, certain components of the Mitter apparatuses described in the Office Action as being "stencil stabilizers," such as elements 3''' of Fig. 11, 3a' of Fig. 13, and 3a'' of Fig. 14, were not disclosed in Mitter as being stencil stabilizers, or in any way stabilizing the stencils of Mitter, but rather were configured as applicators, e.g. flexible squeegees, for spreading a viscous media onto the inner surface of the stencil. The undersigned then pointed out that the Mitter stencil stabilizers (e.g. elements 2 in Figs. 11-14) do not satisfy the limitations recited in Applicant's independent claims 46 and 47. Specifically, with respect to independent claim 46, the undersigned pointed out that the stencil stabilizers of Mitter are not configured to apply a force to the stencil to distort the cross-sectional shape of the stencil into a non-circular shape, as recited in independent claim 46, but, rather, are configured to do exactly the opposite i.e., maintain the circular shape under all conditions (e.g. as taught in Mitter in column 2, lines 10-17; column 4, lines 30-34; column 11, lines 57-61; and column 12, lines 9-12). The undersigned pointed out that unlike the invention set forth in claim 47, which recites that the stencil stabilizer is constructed and positioned so that at least a portion thereof is in essentially continuous contact with the stencil during the entirety of its rotation, Mitter

Serial No.: 09/923,250
Conf. No.: 9145

- 11 -

Art Unit: 2854

continually stresses that his stabilizers are configured to not continuously contact the stencil during operation in order to prevent frictional damage to the stencil (e.g. as taught in column 2, lines 24-31 and column 4, lines 40-48 of Mitter).

The Examiner that the stencil stabilizers recited in independent claims 46 and 47 distinguish those disclosed in Mitter according to their recited function; however, the Examiner requested that Applicant include additional language in each of these claims describing in more detail and with greater clarity the structural configuration of the stencil stabilizer, as it relates to the way that it interacts with and applies the force to the inside surface of the stencil, configured to achieve the recited function. Without conceding that such additional description was necessary to meet the statutory requirements of clarity under 35 U.S.C. §112, paragraph 2, the undersigned, nonetheless, to facilitate allowance of these claims proposed to add language to independent claim 46 reciting that the at least one stencil stabilizer is constructed and positioned to apply a force to "one or more discrete locations on the inside surface of" the stencil and add language to independent claim 47 indicating that the at least one stencil stabilizer is constructed and positioned so that at least a portion thereof is in essentially continuous contact with "one or more discrete locations on the inside surface of" the stencil. The Examiner indicated that these proposed amendments were satisfactory and should place each of the claims in condition for allowance.

Allowable Subject Matter

Claims 3-36 have been allowed.

Serial No.: 09/923,250
Conf. No.: 9145

- 12 -

Art Unit: 2854

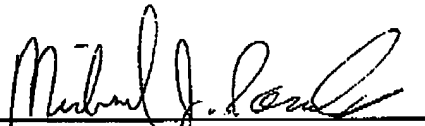
CONCLUSION

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,
William Laird, Applicant(s)

By:


Michael J. Pomirayek, Ph.D., Reg. No.
David Wolf, Reg. No. 17,52846,190
Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, Massachusetts 02210-2206
Telephone: (617) 646-8000

Docket No.: M0459.70021US00
Date: March 11, 2005
x03/14/05x